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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,762	11/14/2001	J. Keith Joung	MTV-030.02	2226

7590 09/13/2004

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EXAMINER

SHIBUYA, MARK LANCE

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/990;762

Applicant(s)

JOUNG ET AL.

Examiner

Mark L. Shibuya

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheets.

3. ☒ Applicant's reply has overcome the following rejection(s): none.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheets.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: n/a.

Claim(s) objected to: n/a.

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: 10-20.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER

Mark L. Shibuya  
Examiner  
Art Unit: 1639

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The proposed amendment will not be entered because the amendment to the claims change the scope of the claims, raise possible issues of new matter and makes the claims vague and indefinite. It is noted that the amendment after final does not cancel the withdrawn claims.

The proposed amendment to claim 1 recites dimerization of a fusion protein to another fusion protein, which changes the scope of the claimed method as drawn to dimerizing test polypeptides. It is unclear as to whether the other fusion protein is the same or different from the first fusion protein. Also, the fusion protein of the claimed invention includes one or more DNA-binding domains, an activation domain, and a *test polypeptide*, *i.e.*, a fusion protein and a test polypeptide are different. Thus, the relationship of the dimerized fusion protein of the proposed amendment and the claimed dimerizing test polypeptide is not clear. Applicant has not pointed, with particularity, as to where in the specification support may be found for dimerization of the entire fusion protein, or some portion of the fusion protein, other than the test polypeptide portion. Therefore the proposed amendment would necessitate further consideration or search.

Applicant's traversal of the scope of enablement and written description rejections under 35 U.S.C. 112, first paragraph, is that by removing previously added language, "introducing a DNA library", the rejections are overcome. This is not persuasive because applicant's arguments do not address the sufficiency of the specification in regards to the scope of enablement and description of the genus of reporter genes.